

REMARKS

Claim 16 has been amended. Claims 1, 2 and 5-19 are pending and claims 5-7 and 9-15 have been withdrawn from consideration. Claims 1, 9, 12, 16 and 19 are the independent claims. No new matter is presented in this Amendment.

REJECTIONS UNDER 35 U.S.C. §102:

Claims 16-18 are rejected under 35 U.S.C. §102(b) as being anticipated by Kozu (U.S. Patent No. 6,451,474).

Regarding the rejection of independent claim 16, it is noted that claim 16 recites a pouch-type lithium secondary battery comprising, amongst other novel features, a battery unit; electrode tabs extending from positive and negative electrode plates of the battery unit; a case having a space to accommodate the battery unit; a sealing surface along the periphery of the space; and a protection circuit board electrically connected to the electrode tabs; wherein end portions of each of the electrode tabs which connect to the protection circuit board extend outside the case, and are bent only once at a substantially right angle with respect to a plane of the sealing surface without extending beyond a thickness of the case forming the pouch-type lithium secondary battery.

The Office Action relies on Figs. 1, 2A and 9A of Kozu for a teaching of some of the features of independent claim 16 and in particular, the Office Action relies on Fig. 9A for a teaching of the electrode tabs which connect to the protection circuit board and extend outside the case, being bent only once at a substantially right angle with respect to a plane of the sealing surface. However, although Fig. 9A illustrates the electrode tabs being bent once, it is noted that this embodiment is not an embodiment of the completed pouch-type battery, but is rather an intermediate step, and therefore, to form a pouch-type battery, it is necessary to bend the electrode tabs 12, once again, as illustrated in Fig. 9B. Furthermore, Applicants note that Fig. 9A cannot be relied upon for a teaching of the tabs being bent only once since such proposed modification would render the battery inoperable since in such position, the battery cannot be sealed. As noted in MPEP 2143.01, "If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125

(Fed. Cir. 1984). Accordingly, Applicants respectfully assert that there is no motivation to modify the battery pack taught by Kozu to maintain the electrode tabs in an upright position.

Furthermore, even if the battery pack illustrated in Fig. 9A were an operable battery and thus taught the electrode tabs being bent only once, it is noted that Fig. 9A clearly illustrates the electrode tabs extending beyond the thickness of the case. Contrary to Kozu, independent claim 16 recites that the tabs are bent only once and do not extend beyond the thickness of the case.

Therefore, Applicants respectfully assert that Kozu fails to teach or suggest, at least, the electrode tabs being bent only once at a substantially right angle with respect to a plane of the sealing surface without extending beyond a thickness of the case forming the pouch-type lithium secondary battery.

Accordingly, Applicants respectfully assert that the rejection of claim 16 under 35 U.S.C. § 102(b) should be withdrawn because Kozu fails to teach or suggest each feature of independent claim 16.

Furthermore, Applicants respectfully assert that the rejection of dependent claims 17 and 18 under 35 U.S.C. §102(b) should be withdrawn at least because of their dependency from claim 16 and the reasons set forth above, and because the dependent claims include additional features which are not taught or suggested by the prior art. Therefore, it is respectfully submitted that claims 17 and 18 also distinguish over the prior art.

REJECTIONS UNDER 35 U.S.C. §103:

Claims 1, 2 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kozu (U.S. Patent No. 6,451,474).

Regarding the rejection of independent claim 1, it is noted that claim 1 recites a pouch-type lithium secondary battery comprising: a battery unit comprising, amongst other novel features, a positive electrode plate, a separator, and a negative electrode plate;; electrode tabs extending from each of the positive and negative electrode plates of the battery unit, respectively; a case having a space to accommodate the battery unit; a sealing surface along the periphery of the space; and a protection circuit board electrically connected to the electrode tabs; wherein portions of each of the electrode tabs extend outside the case, and are bent at a substantially right angle with respect to a plane of the sealing surface, and the protection circuit board is disposed between an outer wall of the case and the bent electrode tabs.

The Office Action recognizes that Kožu does not teach disposing the protection circuit board between an outer wall of the case and the bent electrode tabs. However, the Office Action states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to relocate the protection circuit board of Kožu to a location such as the one recited in independent claim 1 because rearranging parts involves only routine skill in the art.

Applicants respectfully traverse such assertions for at least the following reason.

As noted in MPEP 2144.04, "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

In the instant case, Kožu neither teaches nor suggests a motivation nor provides a reason why one of ordinary skill would place the protection circuit board between the outer wall and the bent electrode tabs. Kožu clearly teaches placing the battery protection device 8 between the electrode tabs and the bottom of case 2b, (see Figs. 9A and 9B) so the connection between the various structural elements accommodated in pack case 2 is made rigid and reliable, making it possible to provide a battery pack 1 which has rigidity in addition to a small thickness that is required for use with mobile equipment.

In other words, Kožu teaches laying the battery protection device flat on the case, with the purpose of reducing the thickness of the battery pack (See Fig. 9B). Therefore, although parts of the device could be rearranged, as noted in the Office Action, the Office Action has not provided any reasoning or motivation why one of ordinary skill in the art would arrange the protection circuit board between an outer wall of the case and the bent electrode tabs, as recited in independent claim 1, since such rearrangement would increase the thickness of the battery pack, which is opposite to the teachings of Kožu (see column 11, lines 53-65).

Accordingly, Applicants respectfully note that that the only motivation to modify Kožu to teach the features recited in independent claim 1, is found in Applicants own specification, and as noted in MPEP 2144.04, the prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification.

Therefore, Applicants respectfully assert that the rejection of claim 1 under 35 U.S.C. §103(a) should be withdrawn because Kozu fails to teach or suggest the novel features recited in independent claim 1.

Regarding the rejection of independent claim 19, it is noted that this claim recites some substantially similar features as recited in claim 1. Thus, the rejection of this claim is also traversed for substantially the same reasons set forth above.

Furthermore, Applicants respectfully assert that dependent claim 2 is allowable at least because of its dependency from claim 1, and because it includes additional features which are not taught or suggested by the prior art. Therefore, it is respectfully submitted that claim 2 also distinguishes over the prior art.

Claim 8 is rejected under 35 U.S.C. §103(a) as being unpatentable over Kozu (U.S. Patent No. 6,451,474) in view of Applicant's Admitted Prior Art (AAPA).

Initially, it is noted that claim 8 depends from independent claim 1, and as noted above, Kozu fails to teach or suggest the novel features recited in independent claim 1.

AAPA, on the other hand, is relied upon for a teaching of features other than those of the independent claim. Therefore, AAPA fails to cure the deficiencies of Kozu and thus fails to teach the novel features of independent claim 1.

Accordingly, Applicants respectfully assert that the rejection of claim 8 is allowable at least because of its dependency from claim 1. Therefore, it is respectfully submitted that claim 8 also distinguishes over the prior art.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge

the same to our Deposit Account No. 503333.

Respectfully submitted,

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